

REMARKS

Applicant appreciates the continued thorough examination of the present application that is reflected in the final Official Action of December 11, 2008. Applicant also appreciates the Examiner's indication that the earlier rejection of independent Claims 11, 31 and 49 under 35 USC §103(a) over U.S. Patent 7,099,837 to Weibel et al. ("Weibel") in view of Applicant's Background of Invention, in further view of Official Notice, has been withdrawn. However, Applicant respectfully requests reconsideration and withdrawal of the new rejection of independent Claims 11, 31 and 49 over Weibel, Applicant's Background of Invention, Official Notice and the newly cited U.S. Patent 5,717,939 to Bricklin et al. ("Bricklin") further in view of newly cited U.S. Patent 6,282,552 to Thompson et al. ("Thompson") for the reasons that now will be described.

In particular, independent Claims 11, 31 and 49 are method, system and computer program product analogs of one another. Accordingly, only Claim 11 will be discussed herein. However, Claims 31 and 49 are patentable for at least the same reasons.

Claim 11 recites:

11. A business directory advertisement billing method comprising:

electronically accessing an electronically linked electronic image of a business directory advertisement that was sold by a third party Customer Marketing Representative (CMR) for a business directory publisher to a CMR customer and a CMR electronic invoice for the business directory advertisement that was sold by the CMR to the CMR customer, in response to granting access to the electronically linked electronic image and electronic invoice by the business directory publisher, the CMR electronic invoice comprising an electronic spreadsheet having data fields therein;

generating a customer electronic invoice for the business directory advertisement that was sold by the CMR to the CMR customer, from the CMR electronic invoice for the business directory advertisement that was sold by the CMR to the CMR customer by adding an additional data field to the data fields in the electronic spreadsheet and/or by altering a data field in the electronic spreadsheet;

electronically linking the electronic image and the customer electronic invoice; and

granting electronic access to the CMR customer to the electronic image and customer electronic invoice that are electronically linked.
(Emphasis added.)

These claims are patentable under 35 USC §103 for at least the following independent reasons:

- (1) the combination of Bricklin into Weibel would destroy the intended operability of Weibel;
- (2) Weibel teaches away from the use of an electronic spreadsheet for an invoice;
- (3) the rejection does not provide the requisite articulated reasoning with a rational underpinning to support the conclusion of unobviousness;
- (4) the independent existence of spreadsheets does not negate unobviousness; and/or
- (5) even if properly combined, the claim elements simply would not be met.

Each of these reasons will now be analyzed separately.

- (1) The combination of Bricklin into Weibel would destroy the intended operability of Weibel

The Official Action concedes, in the first full paragraph of Page 4, that Weibel "...fails to explicitly disclose the CMR electronic invoice comprising an electronic spreadsheet having data fields therein". In an unsuccessful attempt to supply the missing teaching, the Official Action cites the old (filed in 1991) Bricklin patent, which clearly discloses the existence of electronic spreadsheets for invoices. However, it would not be predictable to add a spreadsheet to Weibel's electronic invoice because to do so would destroy the intended operability of the primary reference Weibel.

In particular, Weibel's invoice is an electronic digital document that is used to store a replica of an invoice. Note Figure 1 of Weibel, wherein reference number **10** indicates a document image of a billing statement. Note also element "d." of Claim 1 of Weibel at Column 6, lines 11-14:

- d. creating a second digital document representing an invoice for printed advertisements and associating the unique customer identifier with the invoice and providing the advertising customer with the invoice;....
(Emphasis added.)

A digital document is defined in Weibel Column 1, lines 44-45 as having "a digital document format such as tiff, jpeg, pdf, or the like;...".

Accordingly, provision of a spreadsheet in the invoice digital document would destroy the intended operability of Weibel, which clearly relates to the creation of a digital document that includes a digital image of a billing statement and a digital image of the related advertisement copy, as noted at Weibel Column 1, line 67-Column 2, line 9:

...Copies of the digital documents representing the published advertisement copy and its associated page are linked, or referenced, to the billing document line items and stored as files within the billing statement application. Access from one of the digital documents to any other of its associated digital documents is enabled, e.g., in the manner of hypertext links, so that the publisher and the party being billed may select, display, and examine any document, in essence creating an electronic billing statement and tearsheet system without the need for manual labor.

Thus, substitution of a spreadsheet for the billing invoice document of Weibel would clearly destroy the intended operability of Weibel. It would therefore not be predictable to provide a spreadsheet in the digital invoice document of Weibel.

(2) Weibel teaches away from the use of an electronic spreadsheet for an invoice

By describing in detail the linking of a printed advertisement image document and an invoice digital document, Weibel teaches away from the use of an electronic spreadsheet for an invoice. As recently noted by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc., et al.*, 550 U.S. 1 (2007), when the prior art teaches away from combining certain known elements, discovering of a successful means of combining them is more likely to be nonobvious. *Id.* at 12. For at least these additional reasons, Claim 11 is patentable.

(3) The rejection does not provide the requisite articulated reasoning with a rational underpinning to support the conclusion of unobviousness

The rejection does not appear to have provided the requisite articulated reasoning with some rational underpinning to support the conclusions that were reached in light of the clear teachings of Weibel. In particular, the rationale provided in the middle of Page 4 of the final Official Action is as follows:

...Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include the CMR electronic invoice comprising an electronic spreadsheet having data fields therein. One would be motivated to do so for the benefit of calculating and editing invoice data more easily. (Emphasis added.)

This reasoning is contrary to the clear teachings of Weibel. In Weibel, a separate billing server S1 is used to create bills and then produces the document image shown in Figure 1 of Weibel. Note Weibel Column 3, line 57-Column 4, line 2:

Server S1 is digital system used by a publisher for its advertising order entry functions including advertising order entry, billing, and an accounts receivable system. The advertising order entry Server S1 may be a stand alone machine with a unique software platform and contains digital applications and storage specific to the Server S1 functions. Such server systems are known in the art. On Server S1, an advertisement, also referred to as an "ad", can be scheduled, information about the ad entered, e.g., the run date, placement request, size, proof request, color, and other information specific to this ad. The ad specific information can be retrieved from the Server S1 database using the customer identifier, e.g., the account number, this ad is entered under.

As clearly described, the result of the processing by server S1 is a digital document that represents an invoice. Thus, in Weibel, the "calculating and editing invoice data" referred to by the rationale would be done in the server S1 of Weibel prior to generating the end result digital invoice document. Accordingly, the reasoning provided in the Official Action does not provide the articulated reasoning with some rational underpinning to support the conclusions required by the KSR decision. *Id.* at 14. For at least these additional reasons, Claim 11 is patentable.

(4) The independent existence of spreadsheets does not negate unobviousness.

The independent existence of spreadsheets does not negate unobviousness. In particular, at Page 5 of the Official Action, the Official Action cites the old (originally filed in 1991) Bricklin patent, which describes an electronic invoice comprising an electronic spreadsheet. However, this patent merely describes the independent existence of electronic spreadsheets long before the filing date of Weibel. However, as was recently noted by the Supreme Court in the KSR decision, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known prior art. *Id.* at 14. Accordingly, Claim 11 is patentable for at least this additional reason.

(5) Even if properly combined, the claim elements simply would not be met

Even if it were somehow predictable to combine the five diverse references that have been cited, the claim elements simply would not be met. In particular, as noted above, Claim 11 clearly recites:

...generating a customer electronic invoice for the business directory advertisement that was sold by the CMR to the CMR customer, from the CMR electronic invoice for the business directory advertisement

that was sold by the CMR to the CMR customer by adding an additional data field to the data fields in the electronic spreadsheet and/or by altering a data field in the electronic spreadsheet;.... (Emphasis added.)

The Official Action, at the top of Page 5, cites Thompson as teaching "...generating invoice (see figure 2(210)) and changing electronic invoice by modifying/altering fields, see at least Abstract of Thompson". However, Thompson does not deal with spreadsheets but, rather, deals with Hyper Text Markup Language (HTML) that is used to create controls including checkbox selections, radio buttons, dropdown selection lists, etc. Note Column 3, lines 46-51 of Thompson:

...The raw billing data **211** is combined with interface controls **213** to create an electronic user bill **217**. Interface controls are built using Hyper Text Markup Language (HTML) to create controls including check-boxed selections, radio button or dial-type selections, drop-down selection lists and push button selections.

Note also Column 4, lines 1-6 of Thompson:

...If there is no appropriate category having been defined for a particular call, the user can add additional categories by selecting new category **333** selection of category box **330**. The user then simply types in the new category description in a dialog box (not shown) and the category is inserted as a category entry **331**....

Accordingly, even if the four other references were somehow combined with Thompson, the above-quoted recitations of Claim 11 are simply not described or suggested.

Conclusion

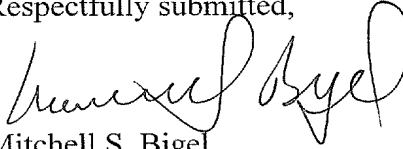
In conclusion, Applicant has now shown that the combination of five separate references (1) would destroy the operability of the primary reference, and that (2) the primary reference actually teaches away from the combination. Moreover, (3) the rejection does not provide the requisite articulated reasoning for the combination but merely demonstrates (4) the independent existence of spreadsheets. Finally, (5) even if somehow combined, the combination would still not yield the claim recitations. Each of these reasons provides an independent basis as to patentability of Claim 11 over Weibel in view of Applicant's Background of Invention, in further view of Official Notice, in further view of Bricklin and further in view of Thompson. The combination of (5) reasons provides compelling evidence.

For at least these reasons, Claim 11 is patentable. Similar analysis applies to Claims 31 and 49. The dependent claims are patentable at least per the patentability of the

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independent claims from which they depend. Accordingly, Applicant respectfully requests withdrawal of the outstanding rejections and allowance of the present application. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,

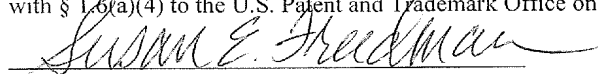


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Susan E. Freedman

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